

I. REAL PARTY IN INTEREST	1
II. RELATED APPEALS AND INTERFERENCES	1
III. STATUS OF CLAIMS.....	2
IV. STATUS OF AMENDMENTS	2
V. SUMMARY OF CLAIMED SUBJECT MATTER.....	2
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.....	3
VII. ARGUMENT.....	3
VIII. CLAIMS APPENDIX	10
IX. EVIDENCE APPENDIX	13
X. RELATED PROCEEDINGS APPENDIX	14

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Bryan E. AUPPERLE, et al.	:	Confirmation Number: 6642
	:	
Application No.: 10/060,996	:	Group Art Unit: 3625
	:	
Filed: January 30, 2002	:	Examiner: Y. Garg
	:	
For: COOPERATIVE E-BUSINESS COMPLEX	:	

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed November 7, 2006, wherein Appellants appeal from the Examiner's rejection of claims 4, 7-8, and 11.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on January 30, 2002, at Reel 012577, Frame 0942.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-4, 7-8, and 11 are pending and three-times rejected in this Application. Claims 5 and 9 have been cancelled, and claims 1-3, 6 and 10 have been withdrawn pursuant to the provisions of 37 C.F.R. § 1.142(b). It is from the multiple rejections of claims 4, 7-8, and 11 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Third Office Action dated August 7, 2006 (hereinafter the Third Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

Referring to Figures 2-3 and 7C-7E, and also to independent claims 4 and 8, a method of cooperatively processing e-business transactions in an e-business complex 200 is disclosed. A plurality of virtual store operators 310 are registered with the e-business complex 200, and the registration establishes a virtual store 240 in the e-business complex 200 (page 24, lines 11-18 of Appellants' disclosure). Window displays of products offered for sale by virtual stores 204 in the e-business complex 200 are provided to individual ones of on-line shoppers 320 (page 29, lines 5-15), and shopper orders for the products are accepted from the individual on-line shoppers 320 (page 25, line 18 through page 26, line 4). The selected store operators 310 operate virtual stores 240 in the e-business complex 200 which correspond to the products ordered by the on-line shopper 320. The selected store operators 310 are notified of the shopper orders (page 26, lines 7-8), and the selected vendors 330 of the shopper orders are also notified, and the selected vendors 330 supply the products offered for sale by the selected store operators 310 (page 26,

lines 14-22). The shopper orders are fulfilled with the products supplied by the selected vendors 330 (page 26, lines 22-23; see also Fig. 7D). Payments for the shopper orders are collected from the on-line shoppers 320 and portions of the payments are distributed to each of the vendors 300 and the store operators 310 (page 28, lines 6-21). The store operators 310 are provided with a catalog of professional services offered for sale by associated professional services providers 340, and at least one transaction for at least one of the professional services is brokered between at least one of the store operators 310 and at least one of the professional service providers 340 (page 28, line 22 through page 29, line 4).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 4, 7-8, and 11 were rejected under 35 U.S.C. § 103 for obviousness based upon Conklin et al., U.S. Patent No. 6,338,050 (hereinafter Conklin), in view of Horn et al., U.S. Patent Publication No. 2002/0156688 (hereinafter Horn), and further in view of Lee, U.S. Patent Publication No. 2005/0187866).

VII. ARGUMENT

THE REJECTION OF CLAIMS 4, 7-8, AND 11 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON CONKLIN IN VIEW OF HORN AND LEE

For convenience of the Honorable Board in addressing the rejections, claims 7-8 and 11 stand or fall together with independent claim 4.

In the Second Office Action dated March 21, 2006, the Examiner rejected the claims under 35 U.S.C. § 103 for obviousness based upon Conklin in view of Horn and Vega. Thus, in the

present Third Office Action, the Examiner has replaced the tertiary reference of Vega with the reference to Lee.

The Examiner's Statement of the Rejection

On page 7 of the Third Office Action, the Examiner asserted the following with regard to the alleged deficiencies of the combination of Conklin and Horn:

Conklin in view of Horn as applied to claim 4 does not teach providing to said store operators a catalog of services offered for sale by associated services providers and, brokering at least one transaction for at least one of said services between at least one of said store operators and at least one of said I service providers.

With regard to the asserted motivation to modify the combination of Conklin in view of Horn, the Examiner asserted the following on pages 7 and 8 of the Third Office Action:

In view of Lee, it would be obvious to one of an art at the time of the applicant's invention to have modified Conklin in view of Horn to incorporate the feature of brokering professional services, such as legal, auditing, translation and tax and accounting services to the store operators of the virtual mall because, as disclosed in Lee, it will advantageously and efficiently facilitate Conklin's system and method in implementing of transactions both domestic and international which require legal and tax counsel/guidance in following the international procedures/rules/regulations and also in translating documents from one language to another language.

Although the Examiner relied upon paragraphs [0008], [0012]-[014], [0055], [0075]-[0076], [0086], [0187], and [0246] of Lee, the Examiner specifically referred to paragraphs [0002]-[0004], and more specifically to lines 9-13 of paragraph [0004]. For ease of reference, certain of these citations are reproduced below:

End investors are the eventual holders of the securities being issued. Other intermediaries include lawyers, accountants, auditors, paying agents, fiscal agents, trustees, and other entities or professionals that provide a service to the issuers or intermediaries. (lines 8-13 of paragraph [0004]).

The present invention is a web-based application that facilitates business transactions, including the raising of capital in global financial markets via the Internet. The invention offers the ability to design, structure, analyze and execute transactions over the Internet. The invention also offers its users direct access to its community, which includes, but is not limited to, issuers, investors, intermediaries, and advisors such as law firms, consulting [sic] firms, accounting firms, and translation agents. (paragraph [0008]).

Appellants also note that the Examiner made the following assertion in the statement of the rejection with regard to the claimed "providing to said store operators a catalog of professional services offered for sale by associated professional services providers":

Presenting or offering of services of lawyers, accountants, auditors, and of other professionals to the issuers and financial intermediaries corresponds to providing a catalog of services offered for sale by associated services providers [corresponds to lawyers, accountants, auditors, and of other professionals].

Appellants' Response

Even assuming arguendo that the combination of Conklin and Horn teaches all the limitations for which Conklin and Horn are being relied upon by the Examiner to teach, one having ordinary skill in the art would not have been motivated to modify the combination of Conklin and Horn in view of Lee so as to arrive at the claimed invention.

The combination of Conklin and Horn could be considered comparable to an e-commerce currently ubiquitous on the internet, such as E-bay's non-auction store operators. These store operators sell their wares over the internet and are found in a common location. The teachings of Lee, however, are directed to a remarkably different type and scope of product that that described by Conklin and Horn. As stated in the Abstract, Lee is directed to a "web-based method and system that facilitates business transactions, including the raising of capital in global financial markets via the Internet." Although the Abstract uses the broad term of "business transactions," the entirety of Lee's teachings is directed to describing how a company can raise capital via the internet. To modify Conklin and Horn in view of Lee would be comparable to taking a Wall Street investment bank and having that bank open up an office in a mall in order to service the needs of proprietors of the shops in the mall to raise capital. In this regard, Appellants submit that such a combination would not be obvious.

Despite the considerable differences between the combination of Conklin and Horn and the teachings of Lee, Appellants note that the Examiner's asserted benefit for the proposed modification (i.e., "it will advantageously and efficiently facilitate Conklin's system and method in implementing of transactions both domestic and international which require legal and tax counsel/guidance in following the international procedures/rules/regulations and also in translating documents from one language to another language") is not factually supported. Specifically, the Examiner has failed to specifically identify a teaching or teachings within Lee that support the Examiner's asserted benefit of the proposed combination.

Regarding the claimed "providing to said store operators a catalog of professional services offered for sale by associated professional services providers," reference is made to the Abstract of Lee, which states the following:

The system provides users direct access to its community, which includes, but is not limited to, issuers, investors, intermediaries, and advisors such as law firms, consultancy firms, accounting firms, and translation agents.

Appellants respectfully submit that providing access to service professionals is not the same as providing a catalog of professional services offered for sale. Even if the Lee taught providing a list of service professionals that could be contacted by a user, this teaching still would not teach or suggest the claimed "catalog of professional services offered for sale." For example, the Examiner referred to paragraph [0075] of Lee, which teaches two different ways a user may seek and engage external professional services. One option is to "send an invitation to various attorneys 76 or a group of law firms describing the kind of legal work required and requesting an estimate of the legal fees," and another option is that "a user may hold a separate auction 76 on the system, through which legal counsel or a law firm(s) may bid for the work." Referring to

paragraph [0076], Lee only teaches that a user is provided with "tools to select a file from the Document Posting 66 and submit a request directly to a translation agent." In all of these teachings by Lee, a description of a catalog of professional services offered for sale, as claimed, is absent.

With regard to this limitation and the other limitations for which Lee is being relied upon to teach, Appellants submit that the Examiner's rejection under 35 U.S.C. § 103 fails to comply with 37 C.F.R. § 1.104(c).¹ Instead, the Examiner's citation of thirteen separate paragraphs of Lee with little indication as to why these certain paragraphs are being cited fails to clearly identify the specific elements within Lee being relied upon in the rejection.

Appellants also note that even if one having ordinary skill in the art were motivated to modify the combination of Conklin and Horn in view of Lee, the claimed invention would not result. The claimed invention is directed to providing store operators, within an e-business complex, with a catalog of professional services and brokering transactions between these store operators. Conklin and Horn describe store operators within an e-business complex, and Lee discusses a web-based system that provides users with the ability to raise capital via the internet. Appellants respectfully submit that to modify the combination of Conklin and Horn in view of Lee would not arrive at the claimed invention. Instead, the web-based capital-raising system of

¹ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Lee would be inserted into the e-business complete of the combination of Conklin and Horn as just another store operator.

Absent from the teachings of the applied prior art and from the Examiner's analysis is a motivation to provide services to store operators in an e-business complex. Brokering services and/or goods between a store operator (i.e., business) and an end user (i.e., consumer), is well known. However, the Examiner has not established that one having ordinary skill in the art would consider, as being obvious, the brokering of services between store operators within an e-business complex.

Therefore, for the reasons stated above, Appellants respectfully submit that the rejection of claims 4, 7-8, and 11 under 35 U.S.C. § 103 for obviousness based upon Conklin in view of Horn and Lee is not viable.

Conclusion

Based upon the foregoing, Appellants respectfully submit that the Examiner's rejection under 35 U.S.C. § 103 is not viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 103.

Application No.: 10/060,996

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: January 8, 2007

Respectfully submitted,

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VIII. CLAIMS APPENDIX

4. A method of cooperatively processing e-business transactions in an e-business complex comprising the steps of:

registering a plurality of virtual store operators with the e-business complex, each said registration establishing a virtual store in the e-business complex;

providing to individual ones of on-line shoppers in the e-business complex, window displays of products offered for sale by virtual stores in the e-business complex, and accepting shopper orders for said products from said individual on-line shoppers;

notifying selected store operators of said shopper orders, said selected store operators operating virtual stores in the e-business complex which correspond to said products ordered by said on-line shoppers;

notifying selected vendors of said shopper orders, said selected vendors supplying said products offered for sale by said selected store operators;

fulfilling said shopper orders with said products supplied by said selected vendors;

collecting payments for said shopper orders from said on-line shoppers and distributing portions of said payments to each of said vendors and said store operators;

providing to said store operators a catalog of professional services offered for sale by associated professional services providers; and,

brokering at least one transaction for at least one of said professional services between at least one of said store operators and at least one of said professional service providers.

7. The method of claim 4, further comprising the steps of:

brokering tax and accounting services between a tax and accounting business partner and individual ones of said store operators; and,

forwarding tax and accounting statements produced by said business partner to said individual ones of said store operators.

8. A machine readable storage having stored thereon a computer program for cooperatively processing e-business transactions in an e-business complex, said computer program comprising a routine set of instructions for causing the machine to perform the steps of:

registering a plurality of virtual store operators with the e-business complex, each said registration establishing a virtual store in the e-business complex;

providing to individual ones of on-line shoppers in the e-business complex, window displays of products offered for sale by virtual stores in the e-business complex, and accepting shopper orders for said products from said individual on-line shoppers;

notifying selected store operators of said shopper orders, said selected store operators operating virtual stores in the e-business complex which correspond to said products ordered by said on-line shoppers;

notifying selected vendors of said shopper orders, said selected vendors supplying said products offered for sale by said selected store operators;

fulfilling said shopper orders with said products supplied by said selected vendors; and,

collecting payments for said shopper orders from said on-line shoppers and distributing portions of said payments to each of said vendors and said store operators;

providing to said store operators a catalog of professional services offered for sale by associated professional services providers; and,

brokering at least one transaction for at least one of said professional services between at least one of said store operators and at least one of said professional service providers.

11. The machine readable storage of claim 8, further comprising the steps of:

brokering tax and accounting services between a tax and accounting business partner and individual ones of said store operators; and,

forwarding tax and accounting statements produced by said business partner to said individual ones of said store operators.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.